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IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Cali St. John

Group Art Unit: 1733

Serial No.: 09/637,242

Examiner: Jessica L. Rossi

Title: BUSINESS METHOD FOR INDICIA WITH SANITARY BEVERAGE CAN

Filing Date: August 14, 2000

Attorney Docket No.: 946-5

**APPELLANT'S REPLY
APPEAL BRIEF**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief responds to the Examiner's Answer in the above identified appeal, which was mailed on March 31, 2006. This reply brief is authorized by 37 C.F.R. § 41.41(a)(1). It adopts by reference the portions of Appellant's (principal) Appeal Brief concerning the real party in interest, related appeals and interferences, status of claims and claims being appealed, status of amendments, summary of claimed subject matter, grounds of rejection to be reviewed on appeal, and the claims appendix, all of which have been conceded in the Examiner's Answer to be correct.

i. Argument

Initial focus in this reply brief is directed to the first claim group on appeal, namely claims 1, 4-5, 7-8, and 12. This claim group was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over the references Kinoian, et al. ("Kinoian") in view of Bozlee. One of the limitations of claim 1 is that the protective members are adhered to the containers to form "a substantially wrinkle free skin tight seal" between the protective member and the beverage container. The presence of a wrinkle free skin tight seal is an important feature of the present invention because it is necessary to prevent contamination from getting under any portion of the protective member where such contamination can come in contact with the container surface. In turn, that is important because of sanitation considerations when consumers drink from the container directly. A study of Kinoian and Bozlee shows that neither reference teaches the "substantially wrinkle free skin tight seal" that is an important limitation of claim 1. The Examiner points to column 3, lines 10-25 and column 4 lines 24-25 of Kinoian as a basis of this rejection, but there is absolutely no such teaching in those lines or anywhere else in Kinoian or Bozlee to support that rejection.

It is well established that a reference only stands for what it actually discloses, an argument that the Examiner does not refute in her Answer. *In re Gordon, et al.*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); *Carl Schenck, A.G. v. Nortron Corp.*, 218 U.S.P.Q.2d 698, 702 (Fed. Cir. 1983); *In re Imperato*, 179 U.S.P.Q.

730, 732 (C.C.P.A. 1973). The Examiner also does not refute the citation to the principle that modification of a reference unwarranted by the disclosure thereof is improper. *Carl Schenck, A.G. v. Nortron Corp.*, *supra*. It is respectfully submitted the citation by the Examiner of Kinoian as teaching a substantially wrinkle free skin tight seal between the protective member and the container is an improper rejection and for that reason alone the Examiner should be reversed. That action is respectfully requested.

Another example of the citation of references for more than what they disclose is the citation by the Examiner of the reference Kagami. This was done in regard to the second claim group in this appeal. The second claim group includes claims 3, 6, 9-10, and 16. The Examiner asserts that Kagami teaches an hourglass configuration for the protective member. An examination of Kagami reveals that it is silent on an hourglass configuration to facilitate adherence to a top and a convex side of a container without deformation or wrinkling of the protective member.

A third example of a citation of a reference for more than what it teaches relates to the third claim group, namely claims 11, 17, and 19. These claims have been rejected on the combination of Kinoian, et al., Bozlee, Kagami, and Ruemer.

Claims 11 and 17 include the limitations that the protective member facilitates using the method for such things as games of chance, premiums, collectibles, redeemables, merchandise acquisition means and prizes without a user knowing in advance of

protective member removal which of a plurality of chances the user has obtained. The only one of the cited references applicable to this limitation in these claims is Ruemer. Ruemer does not teach games of chance, premiums, collectibles, and merchandise acquisition means. Arguably Ruemer only refers to redeemables and prizes. Therefore, the Examiner has again cited a reference for more than it teaches.

The substance of the foregoing three arguments have been raised in the principal brief on this appeal. However, they are raised again to make the point that the Examiner had the opportunity in her Answer to respond to this argument and failed to do so. In point of fact, the Examiner has done exactly the same thing with all the other arguments raised in the principal brief. That is, she has ignored them. In each of the arguments made in the principal brief citing authority that is binding upon the Office, and in each and every instance there has been no response thereto by the Examiner in her Answer.

That is, in each instance the Examiner had the opportunity to specifically point out where in each of the foregoing references the reference included the teaching that the principal brief asserted was absent, and in each instance she failed to do that. It thus can be argued that such is a concession that the references do not contain the limitations that were asserted in the final rejection.

Finally, returning to the rejection of the first claim group, namely claims 1, 4-5, 7-8, and 12, there are three other reasons a

rejection of this claim group based upon the references Kinoian and Bozlee are improper. These are the three well established legal principles that the use of hindsight in combining references, the use of nonanalogous art as a citation when claiming obviousness, and a combination of references where there is no suggestion in the art to combine also make the rejection of this claim group improper. Arguments to this effect are in the principal brief and need not be repeated. However, it is worthy of note that the Examiner has met none of these arguments in her answer. She neither questions nor distinguishes any of these authorities. In fact, the Examiner's Answer is nothing more than a restatement of the final rejection appealed herein.

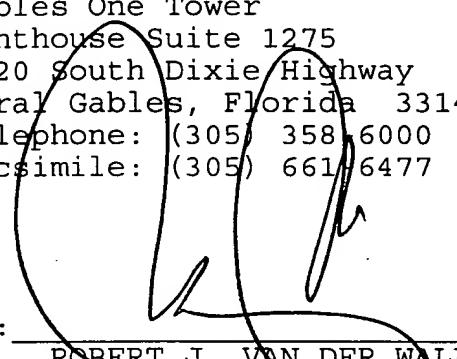
Accordingly, for the reasons, cases and authorities hereinabove and in the principal brief recited, reversal of the Examiner is respectfully requested.

CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing paper has been deposited **May 31, 2006**, with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, which is a date prior to the expiration of the set period, as extended if necessary by the due date falling on a Sunday, and I therefore assert timely filing of the foregoing paper in accordance with 37 C.F.R. § 1.8.

Respectfully submitted,

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